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To: Shalie A. Manlove
Firm: U.S. Patent and Trademark Office
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(including cover)
Comments: Re: U.S. Patent Application Serial No. 10/037,576 filed January 4, 2002
entitled **NON-TOXIC CORROSION-PROTECTION PIGMENTS**
BASED ON COBALT - Our Docket UVD 0279 PA/40815.320

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of

Applicants : Sturgill et al.
Serial No. : 10/037,576
Filed : January 4, 2002
Title : NON-TOXIC CORROSION-PROTECTION PIGMENTS
BASED ON COBALT
Docket : UVD 0279 PA / 40815.320
Examiner : Shalie A. Manlove
Art Unit : 1755
Confirmation No. : 6508

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

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Patricia L. Prior
Patricia L. Prior Reg. No. 33,758

Sir:

REQUEST FOR RECONSIDERATION OF A HOLDING OF ABANDONMENT

This paper is being filed in response to the Notice of Abandonment mailed on December 7, 2004. Applicants respectfully request withdrawal of the Notice of Abandonment because Applicants' Response to Restriction/Election Requirement dated September 16, 2004, was a bona fide attempt to comply with the restriction requirement (as were the previous Responses).

The Examiner indicated that the application was abandoned because of the Applicant's failure to file a proper reply to the restriction requirement. According to the examiner "[t]he Office has required an election of a single disclosed species, i.e. a single compound or element on 3 occasions. Applicants continue to fail to comply with the requirement and instead continue to elect the generic organic valence stabilizer. Therefore, the most recent response is NOT considered a bona fide attempt at a proper response."

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In the Office Action dated March 8, 2004, a restriction requirement was issued as to Group I (claims 1-74, 101, and 102) and Group II (claims 75-100, and 103). The examiner stated that "[c]laims 1-74 and 101-102 are generic to a plurality of disclosed patentably distinct species comprising cationic and anionic solubility control agents as well as organic and inorganic valence stabilizers. Applicant is required under 35 U.S.C. 121 to elect a single species or a single mixture of compounds, even though this requirement is traversed."

In a Response to Restriction Requirement/Election Requirement dated March 16, 2004, Applicants elected Group I without traverse. As to the species election requirement, Applicants also elected, with traverse, claims 1-8, 11-39, 42-63, 66-74, and 101-102. Although it was not stated in the response, this was an election of the organic valence stabilizers and cationic solubility control agents based on the identification of the species in the Office Action. This response was resubmitted on June 1, 2004.

In an Office Action dated June 17, 2004, the examiner stated that the reply was not fully responsive because "Applicant failed to elect species for the restriction." No additional information was provided concerning the problem with the election.

In a Response to Restriction/Election Requirement dated June 30, 2004, Applicants specified that the election (with traverse) was for organic valence stabilizers and cationic solubility control agents. This election was based on the belief that the problem with the previous election was that the species had not been identified (although the claims had been). It was also based on the belief that Applicants were to choose either organic or inorganic valence stabilizers and either cationic or anionic solubility control agents as identified in the March 8, 2004, Office Action.

In an Office Action dated August 24, 2004, the examiner indicated that the reply was not fully responsive because Applicants failed to elect species for the restriction. The examiner stated "applicant must respond by choosing one compound or element from one of the following: a cationic solubility control agent, an anionic solubility control agent, an organic valence stabilizer, and an inorganic valence stabilizer."

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In a Response to Restriction/Election Requirement dated September 16, 2004, Applicants elected, with traverse, organic valence stabilizers, claims 1-8, 13-35, 42-59, 66-74 and 101-102. This election was based on the belief that the problem with the previous election was that Applicants had elected organic valence stabilizers and cationic solubility control agents, and needed to pick one of those two.

The March 8, 2004 Office Action identified the species as "cationic and anionic solubility control agents as well as organic and inorganic valence stabilizers." Although the August 24, 2004, Office Action stated that applicants were to choose "one compound or element from one of the following: a cationic solubility control agent, an anionic solubility control agent, an organic valence stabilizer, and an inorganic valence stabilizer," this was misunderstood in the view of the identification of the species in the March 8, 2004 Office Action.

Thus, Applicants' previous Responses to the Restriction/Election Requirement have been bona fide attempts to respond, and the holding of abandonment should be withdrawn.

The examiner is requiring that applicants choose "one compound or element from one of the following: a cationic solubility control agent, an anionic solubility control agent, an organic valence stabilizer, and an inorganic valence stabilizer." Therefore, Applicants elect, with traverse, an inorganic valence stabilizer: carbonates.

Therefore, applicants provisionally elect, with traverse, claims 1-12, 42-59, 66-67, 71-74, and 101-102 for initial prosecution on the merits.

Claims 1-74 and 101-102 were said to be generic to a plurality of disclosed patentably distinct species comprising cationic and anionic solubility control agents, as well as organic and inorganic valence stabilizers. Therefore, applicants respectfully traverse the present species election requirement because upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim. See 37 CFR §1.141.

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Applicants respectfully submit that the application is in condition for allowance. The Examiner is encouraged to contact the undersigned to resolve efficiently any formal matters or to discuss any aspects of the application or of this response. Otherwise, early notification of allowable subject matter is respectfully solicited.

Respectfully submitted,

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